



UNITED STATES PATENT AND TRADEMARK OFFICE

5/11

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/608,663 | 06/27/2003 | Justin Wade Hart | 06005/39231 | 7072 |

4743 7590 05/27/2005

MARSHALL, GERSTEIN & BORUN LLP
233 S. WACKER DRIVE, SUITE 6300
SEARS TOWER
CHICAGO, IL 60606

EXAMINER

KRISHNAMURTHY, RAMESH

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3753

DATE MAILED: 05/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|----------------------------------|-----------------------------|--|
| Office Action Summary | Application No. 10/608,663 | Applicant(s) HART ET AL. | |
| | Examiner Ramesh Krishnamurthy | Art Unit 3753 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 22 is/are pending in the application.
- 4a) Of the above claim(s) 8 - 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>10/28/04</u> . | 6) <input type="checkbox"/> Other: _____ |

This office action is responsive to communications filed 03/14/2005.

Claims 1 – 22 are pending.

1. Applicant's election with traverse of invention of Group I, claims 1 - 7 in the reply filed on 03/14/2005 is acknowledged. The traversal is on the ground(s) that the combination is not distinct from the subcombination and that the search would not be a serious burden.

The arguments are not found to be persuasive because they fail to evince an appreciation that the inventions claimed are not patentably distinct. The combination claimed does not require all the limitations claimed in the sub-combination. Additionally, the restriction requirement was made on the basis that the claimed inventions are, in fact, patentably distinct, and not on the basis of how they are searched. Applicant's argument that a combined search does not present a serious burden on the examiner does not render the once considered patentably distinct species now not patentably distinct.

It is further noted that the Group II invention, claims 8 – 22, contains two separate inventions and not species as characterized in the response filed 03/14/05.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1 – 7 remain for further consideration. Claims 8 – 22 are withdrawn from further consideration.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3753

3. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 7 recites the limitation "the spring" in line 1. There is insufficient antecedent basis for this limitation in the claim.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 – 3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Miura (US 4,147,179).

Miura discloses a pressure regulator, comprising: a housing (1); an inlet (the line connecting source (25) to the housing (1)) in the housing receiving fluid reduced to a first pressure; an outlet (3) in the housing exhausting fluid compressed at a second pressure; a passage (4) connecting the inlet to the outlet; a plug (6) biased by a spring (12) and movably connected in the housing and disposed in the passage, the plug being movable between a range of positions extending from a first position closing the passage, to a second position fully opening the passage; and a spring-biased reverse pressure exhaust valve (29) in the housing extending between the outlet and the inlet, the reverse pressure exhaust valve being normally closed, the reverse pressure exhaust valve opening when pressure within the outlet exceeds pressure within the

regulator inlet by a predetermined amount. An adjustment mechanism (14) is disclosed for adjusting the bias provided by the spring.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miura (US 4,147,179) as applied to claims 1 – 3 and 6 above, and further in view of Westbrook (US 3,906,786).

The patent to Miura discloses the claimed invention with the exception of explicitly disclosing either a filter or a moisture trap disposed between the inlet and the outlet of the pressure regulator.

The patent to Westbrook discloses that it is known in the art to provide a moisture trap and filter that is disposed between the inlet (downstream of (17)) and the

outlet (upstream of (19)) of the pressure regulator (19) for the purpose of providing a clean and fry fluid supply to points downstream thereof.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided in Miura a moisture trap and a filter for the purpose of providing a clean and fry fluid supply to points downstream of the pressure regulator, as recognized by Westbrook.

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miura (US 4,147,179).

Miura discloses the claimed invention with the exception of explicitly disclosing the spring being sized to open the exhaust valve at about six psi.

Examiner takes official notice that it is well known to choose a spring based on the desired opening pressure and the particular value of six psi is a design choice over those features disclosed in Miura in that it neither solves any stated problem nor provided any new and/or unexpected result.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

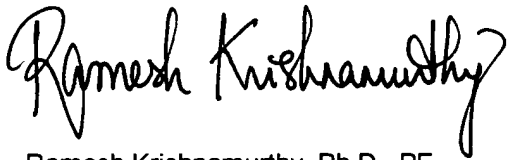
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramesh Krishnamurthy whose telephone number is (571) 272 – 4914. The examiner can normally be reached on Monday - Friday from 10:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene L. Mancene, can be reached on (571) 272 – 4930. The fax phone number for the organization where this application or proceeding is assigned is (703) 872 – 9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308 - 0861.

Art Unit: 3753

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, reading "Ramesh Krishnamurthy". The signature is fluid and cursive, with the first name "Ramesh" and last name "Krishnamurthy" clearly distinguishable.

Ramesh Krishnamurthy, Ph.D., PE
Primary Examiner
Art Unit 3753